REMARKS

In response to the final Office Action dated July 24, 2009, the Assignee respectfully requests continued examination and reconsideration based on the above amendments and on the following remarks.

Claims 1, 5-14, 36, and 39-46 are currently pending in this application.

Rejection of Claims under § 103 (a)

The Office rejected claims 1, 5-6, 36, 40-41, and 44-46 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,005,861 to Humpleman in view of U.S. Patent 6,493,875 to Eames, *et al.* and further in view of U.S. Patent 6,732,366 to Russo.

Humpleman with *Eames*, however, teaches away and cannot support a *prima facie* case for obviousness. The M.P.E.P. expressly explains several situations in which a reference "teaches away," including when a proposed modification "render[s] the prior art unsatisfactory for its intended purpose" or when the proposed modification "change[s] the principle of operation of a reference." *See* M.P.E.P. § 2145 (X)(D). If *Humpleman* is combined with *Eames*, as the Office proposes, then *Eames's* principle of operation must be changed, and these changes render *Eames* unsatisfactory for its intended purposes. Indeed, as the following paragraphs will explain, *Humpleman's* entire teaching of distributing digital signals from each network interface unit over an Ethernet network must be **eliminated**. *Humpleman's* entire teaching of connecting each network interface unit to the switch hub must also be **eliminated**. Because these changes are not permitted, the proposed combination of *Humpleman* with *Eames* cannot support a *prima facie* case for obviousness, so the Office is required to remove the § 103 (a) rejection of claims 1, 5-6, 36, 40-41, and 44-46.

Humpleman's principle of operation is first explained. Separate network interface units each connect to a different external network. *See* U.S. Patent 6,005,861 to Humpleman at

column 3, lines 20-35. Digital signals from each network interface unit are distributed over an Ethernet network. *See id.* at column 3, lines 49-52. Each network interface unit connects to a scalable switch hub and thus to terminal units. *See id.* at column 3, lines 52-55. **A gateway connects to the Ethernet network and to a "local peripheral network" to accommodate "very high bit rate" video devices, audio devices, printers, and other "high bandwidth" peripherals.** *Id.* at column 4, lines 16-32 (emphasis added). Each device's "Ethernet port" is connected by twisted-pair cabling to the switch hub. *See id.* at column 4, lines 38-56.

Eames's principle of operation is entirely different. *Eames* describes a wireless gateway for use in a residence. *See* U.S. Patent 6,493,875 to Eames, *et al.* at column 1, lines 39-45. *Eames's* FIG. 3 illustrates a circuit architecture for the wireless gateway. *See id.* at column 2, lines 37-39. The gateway has a "network interface module" that connects to the access network. *See id.* at column 4, lines 58-60. The network interface module interfaces with a motherboard that contains a processor, memory, MPEG processor, and an Ethernet block. *See id.* at column 5, lines 1-7. "A set of buses" routes information "within [the] gateway." *See id.* at column 5, lines 25-29. "[O]ptional modules" all connect to a "control bus in addition to being connected to at least one other bus." *See id.* at column 5, lines 29-35.

The Office must now realize that "impermissible changes" are required. If *Humpleman* is combined with *Eames*, as the Office proposes, then *Humpleman's* principle of operation must be drastically changed. *Humpleman's* network interface units are distributed over an Ethernet network, but *Eames's* network interface module connects to *Eames's* "set of buses" and to *Eames's* motherboard. The proposed combination of *Humpleman* with *Eames*, then, would require **eliminating** *Humpleman's* entire teaching of distributing digital signals from each network interface unit over an Ethernet network. Indeed, *Humpleman's* entire teaching of connecting each network interface unit to the switch hub must be **eliminated**. These changes are so drastic that *Humpleman* is unsatisfactory for its intended purpose of distributing digital signals to the home Ethernet network.

Even more changes are required. If *Humpleman* and *Eames* are combined, then *Eames's* principle of operation must be drastically changed. *Humpleman's* gateway, that connects *Humpleman's* Ethernet network to *Humpleman's* "local peripheral network," must be replaced with *Eames's* wireless gateway having a set of buses. If *Humpleman* and *Eames* are combined, then *Eames's* network interface module must be **eliminated** to connect to *Humpleman's* Ethernet network. Conversely, if *Humpleman's* Ethernet network connects to *Eames's* Ethernet port 438, then *Eames's* entire teaching of connecting the "network interface module" to the access network must be **eliminated**.

Humpleman with *Eames*, then, teaches away. The proposed combination of *Humpleman* with *Eames* requires **eliminating** significant portions of *Humpleman's* teachings, and these changes render *Humpleman* unsatisfactory for its intended purpose of distributing digital signals to the home Ethernet network. *Eames's* principle of operation must, additionally or alternatively, be drastically changed and entire teachings must be **eliminated**. Because the patent laws forbid changing a principle of operation to support a *prima facie* case, the Office is required to remove the § 103 (a) rejection of claims 1, 5-6, 36, 40-41, and 44-46.

Rejection of Claim 39 under § 103 (a)

Claim 39 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Humpleman*, *Eames*, and *Russo* and further in view of U.S. Patent 4,809,069 to Meyer. Claim 39, though, depends from independent claim 36. The paragraphs above explained how any combination involving *Humpleman* with *Eames* teaches away. The rejection of claim 39 must fail, so the Office is thus respectfully requested to remove the § 103 (a) rejection of this claim.

Rejection of Claims 7 & 42 under § 103 (a)

The Office also rejected claims 7 and 42 under 35 U.S.C. § 103 (a) as being obvious over *Humpleman*, *Eames*, and *Russo* and further in view of U.S. Patent 5,768,527 to Zhu, *et al.* Claims 7 and 42, however, depend, respectively, from independent claims 1 and 36. The

paragraphs above explained how any combination involving *Humpleman* with *Eames* teaches away. The rejection of these claims must fail, so the Office is respectfully requested to remove the § 103 (a) rejection of these claims.

<div align="center">**Rejection of Claims 8-14 & 43 under § 103 (a)**</div>

Claims 8-14 and 43 were also rejected under 35 U.S.C. § 103 (a) as being obvious over *Humpleman*, *Eames*, and *Russo* and further in view of U.S. Patent 6,104,861 to Tsukagoshi and further in view of U.S. Patent 5,473,772 to Halliwell, *et al.*

Claims 8-14 and 43, though, depend from either independent claim 1 or 36. The paragraphs above explained how any combination involving *Humpleman* with *Eames* teaches away. The rejection of these claims must fail, so the Office is respectfully requested to remove the § 103 (a) rejection of these claims.

If any questions arise, the Examiner is invited contact the undersigned at (919) 469-2629 or *scott@scottzimmerman.com*.

Respectfully submitted,

Scott P. Zimmerman
Attorney for the Assignee
Reg. No. 41,390